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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/231,714	01/15/1999	PATRICK E. PATTERSON	09939/003001	2717

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EXAMINER

KANG, PAUL H

ART UNIT	PAPER NUMBER
2142	21

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/132,714	ROBINSON ET AL.	
	Examiner	Art Unit	
	Paul H Kang	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 March 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____ .
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell, US Pat. No. 6,067,526 in view of Gupta et al., US Pat. No. 6,484,156 B1.

3. As to claims 1, 2, 4, 20, 21, 22 and 24, Powell teaches the invention substantially as claimed. Powell teaches a computer program and method of delivering electronic content, the computer program and method comprising:

providing instructions, including web page form instructions displayed on the browser upon selection of a link, that cause a first computer to transmit the first computer's e-mail address to a second computer in response to a request for a first information (Powell, col. 9, line 46 – col. 10, line 51 and col. 13, lines 5-46); and

processing the transmitted information at the second computer and selecting electronic content for transmission and transmitting the selected electronic content to the email address (Powell, col. 9, line 46 – col. 10, line 51 and col. 13, lines 5-46).

However, Powell does not explicitly teach dynamically transmitting the information to the second computer, wherein there is no manual user input of user information. Instead, Powell prompts the user to enter the e-mail and other information prior to transmitting the request (Powell, col. 13, lines 5-46).

In the same field of endeavor, Gupta teaches a system for dynamically transmitting user information to a remote server. Gupta transmits user information dynamically upon user instruction to "Add New Annotation". (see Gupta, col. 13, line 6-37).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated dynamic transmission of information, as taught by Gupta, into the system of Powell for the purpose of increasing the efficiency and user friendliness of the data transfer.

4. As to claim 3, Powell-Gupta teach providing instructions comprising HTML instructions (Powell, col. 9, line 46 – col. 10, line 51 and col. 13, lines 5-46).

5. As to claim 5, Powell-Gupta teach the instructions that cause the first computer to collect information comprise instructions that query the first computer for information (Gupta, see Gupta, col. 13, line 6-37).

6. As to claim 6, Powell-Gupta teach the instructions that cause the first computer to collect information comprise instructions that receive user input (Powell, col. 13, lines 5-46).

7. As to claims 7 and 8, Powell-Gupta teach providing demographic and system information (Powell, col. 10, lines 5-34).

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8. As to claims 9, Powell-Gupta teach processing the information comprising executing a script (Gupta, col. 9, lines 56-67).

9. As to claims 10, Powell-Gupta teach the invention substantially as claimed. However, Powell-Gupta does not explicitly teach processing the information comprising executing a CGI script on the first computer. As applied regarding claim 9, Powell-Gupta does teach the use of a script (Gupta, col. 9, lines 56-67).

Official Notice (MPEP 2144.03) is taken that implementation of CGI scripts in web based communications was well known at the time of the invention. Montulli, US Pat. No. 6,134,592, cited as relevant but not relied upon (paper no. 12), exemplifies the knowledge in the art at the time of the invention regarding the use of CGI scripts.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the use of CGI scripts into the system of Powell-Gupta for the purpose of using a widely accepted and robust programming code.

10. As to claim 11, Powell-Gupta teach the instructions remain at the first computer (Powell, col. 10, lines 5-34).

11. As to claim 12-16, Powell-Gupta teach a system wherein the electronic content comprises text, graphics, audio, video or executable instructions (Powell, col. 9, line 7 – col. 10, line 51 and col. 13, line 5 – col. 14, line 33).

12. As to claims 17-19, Powell-Gupta teach a system wherein the information comprises selecting electronic content based on the transmitted information, and further comprising identification of the instructions and the computer that transmitted the information (Gupta, col. 13, line 6 – col. 14, line 38).

13. As to claim 23, Powell-Gupta teach a system wherein the instructions that cause the processor to select electronic content comprise instructions that cause the processor to use a table that indicates electronic content corresponding to data included in the received information (Powell, col. 16, lines 22-62).

14. Applicant's arguments filed March 6, 2003 have been fully considered but they are not persuasive. The Applicant argued in substance that the combination of Powell-Gupta do not teach all limitations of the claimed invention. See Remarks, page 4. The Applicant, in support of his position, states “[t]he Examiner admits that Powell does not teach dynamically sending of an email from the first computer as discussed in previous office actions.” The Applicant then points out that “Gupta causes any eventual (reply to sender) emailing from recipient to return to the Annotation server and not to the user from where the dynamically sent email originated.”

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Office Action clearly recites the limitations to be taught by Powell and Gupta. Specifically, the steps of sending a user email

address to a server, and the server returning requested information to a user is taught in Powell. See col. 13, lines 12-25. Gupta adds to this teaching the dynamic transmission of user data.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powell can be reached on (703) 305-9703. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Paul H Kang
Examiner
Art Unit 2142

KENNETH R. COULTER
PRIMARY EXAMINER


January 13, 2003